



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,887	03/08/2004	Peter M. Bonutti	780-A04-012-1A	3185

33771 7590 08/07/2007  
PAUL D. BIANCO: FLEIT, KAIN, GIBBONS,  
GUTMAN, BONGINI, & BIANCO P.L.  
21355 EAST DIXIE HIGHWAY  
SUITE 115  
MIAMI, FL 33180

EXAMINER
----------

CUMBERLEDGE, JERRY L

ART UNIT	PAPER NUMBER
----------	--------------

3733

MAIL DATE	DELIVERY MODE
-----------	---------------

08/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/795,887

Applicant(s)

BONUTTI, PETER M.

Examiner

Jerry Cumberledge

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/24/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Waugh et al. (US Pat. 3,869,731).

Waugh et al. disclose a method of performing surgery on a patient's knee, the method comprising: suspending a distal portion of a patient's leg from the knee (column 4, lines 46-50); positioning a guide member against the bone (column 5, lines 21-26); cutting a bone of the knee with a cutting tool while the distal portion of the patient's leg is suspended from the knee (column 4, lines 58-63), said step of cutting includes initiating a cut in the bone while guiding the cutting tool along a guide surface of the guide member to form a cut surface (column 5, lines 21-26), then completing a skim cut (i.e. an anterior femoral cut, as seen in Fig. 2) , while guiding the cutting tool along the cut surface, since the anterior femoral cut must have been made using a guide, as it is such a uniform cut (Fig. 2) (column 5, lines 21-26); and positioning a total knee replacement component against the cut bone of the knee (column 6, lines 11-14 and

Art Unit: 3733

column 6, lines 28-31), wherein cutting the bone includes cutting first and second condyles of the bone (column 4, lines 59-64), wherein the length of the completed cut is at least as long as the distance between the first and second condyles, since the cut is shown extending across the entire end portion of the bone (Fig. 2). Positioning the total knee replacement component includes positioning a first portion of the total knee replacement against the cut bone, and subsequently positioning a second portion of the total knee replacement component against the cut bone (column 6, lines 11-14 and column 6, lines 28-31). The method further includes the step of connecting the first and second portions of the total knee replacement component after both portions have been positioned against the cut bone (Fig. 2). Suspending the distal portion of the patient's leg from the knee includes bending the knee to a flexed condition (column 4, lines 48-50), and cutting the bone of the knee includes cutting the bone of the knee while the knee is bent in the flexed condition (column 4, lines 58-64). Bending the knee includes hyperflexing the knee (Fig. 1)(column 4, lines 58-64), and cutting the bone of the knee includes cutting the bone of the knee while the knee is hyperflexed (column 4, lines 58-64).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waugh et al. (US Pat. 3,869,731) in view of Sherwin (US Pat. 3,750,652).

Waugh et al. disclose the claimed method except for the method further includes distracting the knee while the distal portion of the patient's leg is suspended from the knee, and wherein at least one of the steps of cutting the bone and positioning the total knee replacement component is performed while the knee is distracted.

Sherwin discloses distracting the knee (column 1, lines 58-67) during a surgical procedure (column 1, lines 1-10), in order to allow increased visibility to the area that the surgery is being performed on (column 1, lines 40-41 and column 1, lines 58- 67).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have added the step of distracting the knee during a surgical procedure as taught by Sherwin to the method of Waugh et al., in order to allow increased visibility to the area that the surgery is being performed on (column 1, lines 40-41 and column 1, lines 58- 67).

Claims 9, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waugh et al. (US Pat. 3,869,731) in view of Shapiro (US Pat. 4,565,192).

Waugh et al. disclose the claimed method except for the method further includes displacing a patella of the knee. The method further includes cutting the patella while the patella is displaced. The patella is displaced with an inner side of the patella

remaining facing inward. The method further includes everting a patella of the knee. The method further includes cutting the patella while the patella is everted.

Shapiro discloses displacing a patella of the knee (column 10, lines 21-26). The method further includes cutting the patella while the patella is displaced (column 10, lines 29-36). The patella is displaced with an inner side of the patella remaining facing inward, since, as the patella is first being displaced, it will still be facing inward as it normally is (column 10, lines 21-26). The method further includes everting a patella of the knee (column 10, lines 21-26). The method further includes cutting the patella while the patella is everted (column 10, lines 29-36). These steps allow for the implantation of a prosthesis in order to restore the diseased patella to normal functioning (column 2, lines 64-67 and column 3, lines 1-2).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have added the steps of displacing a patella and cutting a patella as taught by Shapiro to the method of Waugh et al., in order to allow for the implantation of a prosthesis in order to restore the diseased patella to normal functioning (column 2, lines 64-67 and column 3, lines 1-2).

Claims 9, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waugh et al. (US Pat. 3,869,731) in view of Waddell (US Pat. 6,174,314).

Waugh et al. disclose the claimed method except for the method further includes displacing a patella of the knee. The method further includes cutting the patella while

the patella is displaced. The patella is displaced with an inner side of the patella remaining facing inward. The inner side of the patella remains facing inward during the cutting and positioning steps.

Waddell discloses displacing a patella of the knee, since as the knee is moved (column 3, lines 22-24) the patella will be displaced. The method further includes cutting the patella while the patella is displaced (column 3, lines 29-32). The patella is displaced with an inner side of the patella remaining facing inward (column 8, lines 14-15). The inner side of the patella remains facing inward during the cutting and positioning steps (column 8, lines 14-15). Not everting the patella during the procedure decreases the failure of total knee arthroplasty (column 2, lines 63-67 and column 3, lines 1-8).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have added modified the method of Waugh et al. with the step of displacing the patella and not everting the patella, in order to decrease the failure of total knee arthroplasty (column 2, lines 63-67 and column 3, lines 1-8).

Claims 15-18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Techiera (US Pat. 6,106,529) in view of Waugh et al. (US Pat. 3,869,731).

Techiera discloses a method of performing surgery on a patient's joint, the method comprising: positioning a guide member against a bone of the joint (column 3, lines 48-54), the guide member having a guide surface (Fig. 1); positioning a cutting tool

Art Unit: 3733

in association with the guide surface of the guide member (column 3, lines 8-10)(column 5, lines 45-54); initiating a cut in the bone while guiding the cutting tool along the guide surface to form a cut surface (column 3, lines 8-10)(column 5, lines 45-54); continuing the cut in the bone while guiding the cutting tool along the cut surface (column 3, lines 8-10) (column 5, lines 45-54). The method further includes positioning an implant against the cut bone (column 53-56). Positioning the implant includes positioning first and second portions of the implant against the cut bone (column 3, lines 37-41, *i.e.* components are positioned). Positioning first and second portions of the implant includes connecting the first and second portions of the implant (column 1, lines 33-38). Initiating the cut and completing the cut are performed on a condyle of the bone (column 1, line 67 and column 2, lines 1-6), and further including positioning a partial joint replacement component against the cut condyle of the bone (column 53-56). Initiating the cut and completing the cut are performed on both condyles of the bone (column 1, lines 50-67 and column 2, lines 1-6)(column 5, lines 24-30), and further including positioning a total joint replacement component against the cut condyles of the bone (column 1, lines 25-30). The method further includes completing the cut while guiding the cutting tool along the cut surface (column 2, lines 61-65). The method further includes removing the guide member from the bone before continuing the cut (column 6, lines 46-50). The guide surface comprises a guide slot and the step of positioning a cutting tool includes inserting the cutting tool into the guide slot (column 5, lines 45-54).

Techiera does not disclose the step of positioning a first portion of a total knee replacement component against the cut bone, and subsequently positioning a second



Art Unit: 3733

portion of the total knee replacement component against the cut bone; and connecting the first and second portions of the total knee replacement component after both portions have been positioned against the cut bone, each of the first and second portions of the total knee replacement component having an articulating surface.

Waugh et al. discloses a step of knee surgery (abstract) comprising a step of positioning a first portion of a total knee replacement component against the cut bone (column 6, lines 11-27), and subsequently positioning a second portion of the total knee replacement component against the cut bone (column 6, lines 28-28-31); and connecting the first and second portions of the total knee replacement component after both portions have been positioned against the cut bone (column 6, lines 43-49), each of the first and second portions of the total knee replacement component having an articulating surface (Fig. 2). This type of two-part prosthesis is useful in that it allows for flexion, rotation, rolling and sliding movements substantially reproducing those movements of the normal human knee (column 2, lines 16-24).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the method of Techiera with the prosthesis of Waugh et al. and its associated method steps in order to provide a total knee replacement that allows for flexion, rotation, rolling and sliding movements substantially reproducing those movements of the normal human knee (column 2, lines 16-24).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Techiera in view of Waugh et al. (US Pat. 3,869,731).

Techiera discloses the claimed method except for suspending a distal portion of a patient's extremity connected with the joint, and initiating the cut and completing the cut are performed while the distal portion of the patient's extremity connected with the joint is suspended.

Waugh et al. disclose suspending a distal portion of a patient's extremity connected with the joint (column 4, lines 46-50), and initiating the cut and completing the cut are performed while the distal portion of the patient's extremity connected with the joint is suspended (column 4, lines 58-63). This, in part, provides excellent exposure to the anterior aspect of the entire knee joint (column 4, lines 52-53).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the method of Techiera with the step of suspending a portion of the extremity and cutting the extremity while suspended as taught by Waugh et al. This step would provide better exposure to the anterior aspect of the entire knee joint.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Techiera (US Pat. 6,106,529) in view of Waugh et al. (US Pat. 3,869,731) in view of Sherwin (US Pat. 3,750,652).

Techiera in view of Waugh et al. disclose the claimed method except for distracting the joint, and wherein at least one of the steps of positioning the guide member, positioning the cutting tool, initiating the cut, and completing the cut is performed with the joint distracted.

Art Unit: 3733

Sherwin discloses distracting a joint (column 1, lines 58-67) during a surgical procedure (column 1, lines 1-10), in order to allow increased visibility to the area that the surgery is being performed on (column 1, lines 40-41 and column 1, lines 58- 67).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have added the step of distracting the knee during a surgical procedure as taught by Sherwin to the method of Techiera, in order to allow increased visibility to the area that the surgery is being performed on (column 1, lines 40-41 and column 1, lines 58- 67).

Claims 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Techiera (US Pat. 6,106,529) in view of Matsen, III et al. (US Pat. 4,979,949).

Techiera discloses a method of performing a total knee arthroplasty surgery on a leg of a patient, the method comprising: positioning a guide member against a bone of a knee joint in the leg of the patient (column 3, lines 48-54), the guide member having opposite ends with a transverse dimension which is less than a distance between medial and lateral epicondyles of an end portion of the bone (Fig. 1); positioning a cutting tool in association with a guide surface of the guide member (column 1, line 67 and column 2, lines 1-6); initiating a cut in the bone while guiding the cutting tool along the guide surface to form a cut surface (column 1, line 67 and column 2, lines 1-6); and continuing the cut in the bone while guiding the cutting tool along the cut surface (column 1, line 67 and column 2, lines 1-6), wherein both medial and lateral condyles of the end portion of the bone are cut by the cutting tool (column 1, line 67 and column 2,

Art Unit: 3733

lines 1-6). The method further includes positioning an implant against the cut bone (column 1, lines 18-21). The guide member is mounted to the bone (Fig. 1) and offset from a central longitudinal axis of the bone (column 2, lines 20-25). The guide member is intramedullary mounted to the bone (column 4, lines 36-41). The guide member is extramedullary mounted to the bone (column 4, lines 62-64). The guide is operative when at least half of the guide body is disposed laterally to a line defining the longitudinal axis of the bone to be cut. The guide is operative when at least one end is positioned between the skin and the bone to be cut. With regard to the guide being operative, the Examiner is interpreting this as meaning the guide is capable of being operated when the guide is placed as claimed, but is not required to be operated when the guide is placed as claimed.

Techiera discloses the claimed invention except for the method including the step of angularly disposing the cutting tool along the guide surface in order to cut a section of the bone wider than the width of the guide.

Matsen, III et al, discloses a method of knee surgery (Fig. 3) in which a saw blade is angled with respect to a guide surface (column 23, lines 43-52), so that the guide can be used near a bone end in a manner that minimally interfaces with the overall view of the bone (column 23, lines 43-52).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the method of Techiera with the step of angularly disposing the cutting tool along the guide surface, which would allow the guide

Art Unit: 3733

to be used near a bone end in a manner that minimally interfaces with the overall view of the bone (column 23, lines 43-52).

With regard to claim 28, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the transverse dimension of the opposite ends of the guide member of Techiera in view of Waugh et al. being less than two-thirds the distance between the medial and lateral epicondyles of the end portion of the bone, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Response to Arguments***

Applicant's arguments filed 05/23/2007 have been fully considered but they are not persuasive.

With regard to Applicant's argument that Waugh does not disclose guiding the cutting tool along the guide surface of the guide member to form a cut surface and completing a cut in the bone while guiding the cutting tool along the cut surface, the Examiner respectfully disagrees. Waugh discloses using a guide in combination with a saw in order to make a cut in a bone (column 5, lines 21-24). With regard to the skim cut (i.e. an anterior femoral cut, as seen in Fig. 2), the anterior femoral cut must be made using a guide, as it is such a uniform cut (Fig. 2) (column 5, lines 21-26) and Waugh discloses using a guide (column 5, lines 21-24).

Art Unit: 3733

With regard to arguments regarding the amendments made to the, they have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

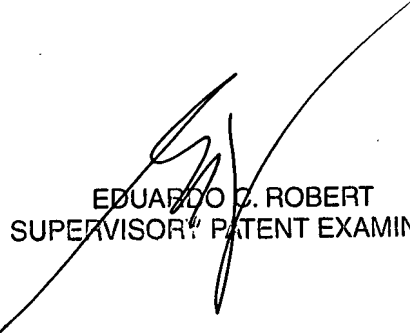
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER